

**REMARKS**

Claim 23 stands previously allowed.

Claims 17-19 stand objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 17 has been rewritten in independent form to include all of the limitations of the base claim and intervening claims. As such, claim 17 should be in condition for allowance, and such is respectfully requested. Claims 18 and 19 depend from claim 17, and should therefore be allowable. Allowance of claims 18 and 19 is also respectfully requested.

Claims 13-15 and 20-22 stand rejected under 35 U.S.C. § 103(a) as being obvious over Black et al (US 6,494,305) in view of Chapman et al (US 3,651,704) and Blankenship et al (US 6,267,291). Claim 16 stands rejected under 35 U.S.C. § 103(a) as being obvious over Black et al (US 6,494,305) in view of Chapman et al (US 3,651,704), Blankenship et al (US 6,267,291), and Robrig (US 4,717,370). Claims 13-16 and 20-22 are addressed below.

**Claim 13**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Even if it would have been obvious to modify Black ('305) by Chapman ('704) to create a lighter weight system as the Examiner suggests on page 4 of the 6/29/2005 Office Action, there would be absolutely no suggestion or motivation to combine the combination of Black ('305) and Chapman ('704) with Blankenship ('291), and the

Examiner's combination of Black ('305), Chapman ('704) and Blankenship ('291) clearly constitutes impermissible hindsight.

In explaining the motivation to combine on page 4 of the 6/29/2005 Office Action, the Examiner writes:

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to rearrange the location of the block having the RF tag of Black et al/Chapman et al from the trolley to the surface/recess between the hub and rim as taught by Blankenship et al in order to provide Black et al/Chapman et al with a more secure system wherein the block is mounted within the recess between the hub and the outer rim of the wheel instead of exposing on the outer surface of the trolley, and thus preventing separation of the tag from the system during conveying and handling.

This separation problem is not found in any reference cited by the Examiner, and to applicant's knowledge, separation has not been a problem experienced in the prior art. A reference to tag damage may be found on page 2, lines 19-21 of applicant's specification as filed, however. Applicant respectfully contends that the Examiner has used impermissible hindsight and a faulty reading of applicant's disclosure to combine elements of various references. This is clearly contrary to the requirement of *In re Vaeck*, 947 F.2d 488 that "The teaching or suggestion to make the claimed combination ... must ... be found in the prior art and not based on applicant's disclosure."

Blankenship ('291) discloses attaching an RFID tag or button to a welding wire reel flange (Figs. 10-11; col. 10, lines 8-17). There is nothing in Blankenship ('291) or in any other reference cited by the Examiner that suggests mounting an RFID tag in an annular recess of a wheel (as claimed by applicant), or indeed in any recess whatsoever. As one of ordinary skill in the art would have had no motivation whatsoever to combine various references to overcome an unarticulated and unidentified problem, or to combine these particular references in this manner, applicant respectfully requests allowance of claim 13 and the claims that depend therefrom.

Further, the combination of Black ('305), Chapman ('704) and Blankenship ('291) does not teach or suggest all of applicant's claim limitations as required by *In re Vaeck*. There is no teaching in any of the Examiner's references to mount an RFID tag in any recess, much less in an annular recess of a wheel as claimed by applicant. As such,

applicant respectfully requests allowance of claim 13 and the claims that depend therefrom.

The Examiner has also noted that "employing the RF tag directly on the wheel instead of on the trolley is simply a rearrangement of parts, and therefore an obvious expedient" (6/29/2005 Office Action, page 5). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). As discussed above, the prior art here clearly does not provide the required motivation, and as such, applicant respectfully requests allowance of claim 13 and the claims that depend therefrom.

#### Claims 14, 20, 21, and 22

The Examiner has not specifically addressed all of the subject matter in claims 14, 20, 21, and 22. More particularly, the Examiner has failed to address the limitations that "said FR tag is imbedded in a first block of material shaped to conform to a portion of said first annular recess" (claim 14); "the block of material being shaped to fit between the hub and the outer rim of the wheel" (claim 20); "block of material shaped to fit within the recess" (claim 21); and "block of material shaped to fit between the hub and outer rim of the wheel adjacent the web" (claim 22). It follows, then, that all of applicant's claim limitations have not been taught or suggested as required by *In re Vaeck*. As such, applicant respectfully requests allowance of claim 14, claim 16 which depends therefrom, and claims 20-22.

The arguments presented above for claim 13 regarding motivation, hindsight, and the teaching or suggestion of every claim limitation also apply to the position of the RF tag in claims 20-22. Claims 20-22 are also in condition for allowance for this reason, and such is respectfully requested.

Claim 15

Just as there is nothing in the prior art that teaches or suggests placing an RF tag in an annular recess of a wheel, there is nothing in the prior art that teaches or suggests placing an RF tag in a particular annular recess of a wheel as set forth in claim 15. Further, the Examiner has also failed to address this limitation. Again, all of applicant's claim limitations have not been taught or suggested as required by *In re Vaeck*, and as such, applicant respectfully requests allowance of claim 15.

Claim 16

There is nothing in the prior art that teaches or suggests imbedding an RF tag in the dampening element of Rohrig ('370), and due to the deformation of the dampening element (col. 3, lines 28-31), there can be no reasonable expectation of success in doing so. As such, these references do not teach or suggest imbedding an RF tag in a first block of material shaped to conform to a portion of said first annular recess, and any expectation of success in imbedding an RF tag in the dampening element of Rohrig ('370) using impermissible hindsight reasoning is dubious. All of applicant's claim limitations have not been taught or suggested as required by *In re Vaeck*, and there is no reasonable expectation of success as required by *In re Vaeck*. As such, applicant respectfully requests allowance of claim 16.

Applicants believe that no fees are due in connection with this amendment. If any additional fee is due, please charge Deposit Account No. 12-0600.

In view of the above, applicant requests allowance of the claims not above cancelled and asks that this application pass to issue. In the alternative, applicant requests that rejections of claims 14, 15, 20, 21, and 22 in the next Office Action not be made final. Since subject matter was not addressed in claims 14, 15, 20, 21, and 22, any final rejection of these claims on the next Office Action would in effect deny applicant the opportunity to define his invention in claims that will give him the patent protection to which he is justly entitled, directly contrary to MPEP 706.07.

In view of the above Amendments and Remarks, Applicant has addressed all issues raised in the Office Action dated 29 June 2005. Should any issues remain, the Examiner is encouraged to telephone the undersigned attorney.

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